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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/090,067 | 06/03/1998 | JAMES D. REDMOND | NIS0007 | 3497 |

23735 7590 03/26/2003

DIGIMARC CORPORATION
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SUITE 100
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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/090,067

Applicant(s)

REDMOND ET AL.

Examiner

Mark T Henderson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16,18-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16,18-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. The request filed on March 5, 2003 for a Continued Examination under 37 CFR 1.114 based on parent Application No. 09/090,067 is acceptable and a RCE has been established. An action on the RCE follows.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-6, 8-11, 13-16, 18-21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent (GB-2159461A) in view of Dow (1,428,278) and further in view of Waly (3,704,068).

UK Patent '461 discloses a document and method for manufacturing tamper-resistant identification cards comprising first printed matter (not seen, but mentioned in Col 2, lines 120-125) at a first location and a first scale, wherein the first printed matter is viewable by a person without magnification; a second printed matter (3) representing the first printed matter rendered at a second scale and location and in a second color, wherein the second scale (micro print) being significantly smaller than the first scale rendering the second printed matter not ascertainable (Col. 2, lines 125-129) by the naked eye under during normal use, but can be viewed by a projector; and wherein the second location being spaced from the first location; and wherein the first and second printed matter conveys identifying information and is specific to the identified person (Col. 2, lines 107-115 and 120-123).

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Patent '461 further discloses a method of printing a document which is inherently taught.

However, UK Patent '461 does not disclose minimal contrast hiding printed matter from the naked eye wherein the printed matter and a background color are printed in various hues; wherein the second printed matter conveys the same identifying information as the first printed matter; wherein the second printed matter is unresolved unless the second printed matter is viewed using a lens; and a plurality of identification documents.

Dow discloses in Fig. 2 and 3, a document comprising printed matter in a first color and the background printed matter in a second color, wherein there is minimal contrast hiding between the printed matter and its immediate background which makes it hidden from the naked eye. (Col. 1, lines 41-51, and Col. 2, lines 63-71).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK Patent '461 document to include minimal contrast hiding between two colors as taught by Dow for the purpose of preventing the document from being counterfeited.

However, UK Patent "461 as modified by Dow does not disclose wherein the second printed can only be view using a magnification lens.

Waly discloses in the abstract, a reader wherein during non-normal use, a micro prints (micro-originals) can be placed into the reader with a lens adapted to enlarge(magnify) a micro image.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK's and Dow's document to be placed in a reader comprising a magnifying lens as taught by Waly for viewing purposes.

In regards to **Claim 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct any desirable amount of identification documents, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 18-20**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia for the first and second printed matter, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. In regards to the first printed matter being the same identifying information as the second printed matter, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re*

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Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the second matter is capable of being a copy of the first printed matter.

Response to Arguments

3. Applicant's arguments filed on June 5, 2002 have been fully considered but they are not persuasive.

In response to applicant's arguments that the UK reference does not teach viewing the microprint with the naked eye with a magnifying lens, the examiner submits that the UK reference states that the microprint can not be viewed with the naked eye during normal use, however, the microprint can be viewed with the naked eye when using a projector or reader. The Waly reference is now used to disclose a reader having a magnification lens to view a microprint with the naked eye. The applicant should disclose in further detail the structure of the identification document.

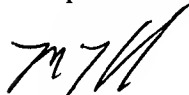
In response to applicant's argument that the Dow reference does not teach the "use of a combination or printing information at a second scale and using minimal contrast as a way to further conceal its specifically colored security information", the examiner submits that the UK reference is relied upon for disclosing the use of printing information at a second scale to conceal the second printed matter information. The UK reference also discloses that the second printed

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matter is in a second color. The Dow reference is relied upon for disclosing color variation between a first and second printed matter wherein there is minimal contrast between the two colors. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK Patent '461 document to include minimal contrast hiding between two colors as taught by Dow for the purpose of preventing the document from being counterfeited.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 20, 2003



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